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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,883	03/16/2001	David Thomas	TNX98-08-01	2201

26839 7590 12/23/2004

TANOX, INC.
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EXAMINER

WEHBE, ANNE MARIE SABRINA

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/810,883

Applicant(s)

THOMAS ET AL.

Examiner

Anne Marie S. Wehbe

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 December 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 29-44.

Claim(s) withdrawn from consideration: 45 and 46.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

ATTACHMENT TO ADVISORY ACTION

2. CONT. The amendment adds an additional negative limitation to the claims which seeks to exclude homologues of KIR as the ITIM in the claims. This newly added negative limitation would require additional further search and consideration.

5. CONT. Applicant's arguments have not been found persuasive in overcoming the rejections of record.

Regarding the new matter rejection, the applicant argues that support for "KIR" does not have to be literal, and that the disclosure of the genus of proteins containing an ITIM inherently discloses KIR, citing *In re Wertheim*. In response, the instant situation is not comparable to that of *In re Wertheim* which is directed to support for range limitations. In the instant case, the negative limitations seek to narrow the subject matter claimed to a particular subgenus of the broadly disclosed genus originally claimed and supported by the specification. In such cases, the courts have stated that, "whatever may be the viability of an inductive-deductive approach to arriving at a claimed subgenus, it cannot be said that such a subgenus is necessarily described by a genus encompassing it" MPEP 2163.05 (II) , citing *In re Smith* 458 F.2d 1389, 1395 (1972). Further, the MPEP states that introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement. MPEP 2163.05 (II). Therefore, applicant's arguments are not found persuasive.

Regarding the rejection of the claims under 102 or 103, applicant's arguments are based on the entry of the proposed claim amendments, as the amendment has not been entered, these arguments have not been found persuasive.

Please note as well that the proposed amendment does not comply with the requirements of 37 CFR 1.121(c). Claims 45-46 were withdrawn from prosecution in previous office action. As such, 37 CFR 1.121(c) requires that these claims be identified as (withdrawn), not

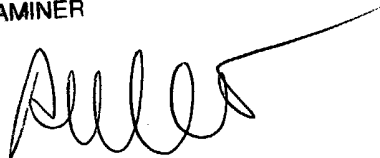
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(previously presented). Applicant is advised that future amendments must comply with the requirements of 37 CFR 1.121 in providing the correct claim identifiers for each claim.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. The examiner can be reached Monday- Friday from 9:30-6:00 EST. If the examiner is not available, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. For all official communications, **the new technology center fax number is (571) 273-8300**. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Anne M. Wehbé', with a long horizontal line extending from the end of the signature.